

an alkylcarboxylic acid; (k) an arylcarboxylic acid; (l) an alkylphosphonic acid; and (m) an arylphosphonic acid, and at least one of compounds selected from the group consisting of:

(1) a homopolymer comprising a bismaleimide, (2) a homopolymer comprising a maleimide-terminated oligomer, and (3) a homopolymer comprising a maleimide-terminated polymer,

wherein the coating is applied from an aqueous solution, an organic solvent solution, a dispersion or an emulsion; and

subsequently stabilizing the bond coating on the substrate surface. --

#### REMARKS

The Examiner objected to the disclosure and rejected claims for adding new matter. Applicant traverses these objections and rejections. In any event, applicants add new independent claims 51-54 which are unaffected by the asserted new matter objection/rejections. Claims 51-54 reflect a narrower claim scope discussed with the Examiner. Moreover, claims 51-54 are narrower in scope than independent claims 28 and 29.

#### OBJECTION TO THE DISCLOSURE

The Examiner objected to the amendment dated November 23, 2001 for introducing alleged new matter into the disclosure. See 35 U.S.C. § 135. In particular, the Examiner objected to certain claim limitations precluding

compounds that do not undergo a Diels-Alder reaction.

Applicants traverse the objection. The previously submitted Negele Declaration demonstrates that the disclosure provides sufficient support for the claim limitation precluding compounds that do not undergo a Diels-Alder reaction.

#### REJECTION UNDER 35 U.S.C. § 112, 1<sup>st</sup> PARAGRAPH

Claims 28-50 were rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as allegedly containing subject matter which was not described in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention. Applicants traverse the rejection, and rely upon the previously submitted Negele Declaration. It is respectfully submitted that the added material is not new matter and is fully supported by the original disclosure.

#### REJECTIONS UNDER 35 U.S.C. § 103

Claims 28-30, 32-35, 38-47, and 50 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,496,695 ("Sugio"). Claims 28-30, 32-50 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,084,304 ("Lienert"). Applicants respectfully traverse these rejections.

Sugio discusses a curable resin composition for use in electronic applications (col. 2, ll. 24-26), but provides no disclosure of or teaching that the recited polybismaleimide compounds may be used in a corrosion-inhibiting bond coating on

a metal substrate. The Examiner conceded that Sugio "does not explicitly disclose the recited thickness or pre-coating steps".

The Lienert reference is directed to "a one-coat or two-coat application, only polyesterimides and polyhydantoins [but not polybismaleimides] being used for the primers [i.e. bond coating] as high temperature resistant systems." (See Lienert abstract; col. 11, ll. 50-60.) But the method as claimed by applicants is not disclosed by Lienert. Unlike Lienert, applicants' claimed polybismaleimide bond-coating is both adhesion-conferring and corrosion-inhibiting, and it can serve as a primer. The Office Action concedes that Lienert "does not explicitly disclose the recited pre-coating steps".

For both asserted references, the Examiner acknowledged that claimed limitations in the independent and dependent claims are not explicitly disclosed (and further fails to show they are implicitly disclosed). But it is nonetheless asserted that the missing limitations (in the independent as well as the dependent claims) simply "would have been obvious to a person of skill in the art at the time the invention was made." These are inappropriate rejections. Indeed, the Federal Circuit recently admonished the Patent Office against rejections based on common sense, common knowledge, or bald assertions of obviousness. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Since none of the cited references explicitly (or implicitly) discloses, suggests or teaches the method recited in the new claims, applicants believe the claims are in condition for allowance and respectfully request their early allowance.

## CONCLUSION

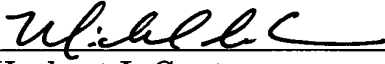
Applicants respectfully request that the disclosure objection and claim rejections be withdrawn, and that the pending claims and newly-added claims be allowed to issue.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #225/44173).

Respectfully submitted,

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